

REMARKS

Reconsideration of this application is respectfully requested in view of the remarks contained herein.

STATUS OF CLAIMS

Claims 20, 21, 23-30, 34-40, 48 and 49 are currently pending in this application.

WITHDRAWN REJECTIONS

As indicated in paragraph 2 of the Office Action, the Examiner has withdrawn all of the rejections over Ozaki, based upon the declaration under 37 C.F.R. 1.132 previously submitted. The Examiner has also withdrawn the rejection over Rutz in view of Kondo, in view of the arguments previously submitted.

OBVIOUSNESS REJECTIONS

On pages 3-8 of the Office action dated March 3, 2009, the Office has rejected claims 20-30, 34-40 and 48-49 under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,154,881 ("Rutz") in view U.S. Patent No. 4,244,738 ("Storchheim").

First, Applicants submit that they have previously established (via the declaration filed under 37 C.F.R. § 1.132) that any *prima facie* case of obviousness over Ozaki has been rebutted, and the Office has admitted this in its withdrawal of the Ozaki reference. Accordingly, Applicants have shown the claimed invention to be unobvious over the closest prior art reference cited by the Office. Now, the Office makes yet another rejection over yet another combination of references that is even further removed from the claimed invention than was Ozaki. In this regard, Applicants note that MPEP § 706 states:

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the

claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

MPEP § 706 (emphasis added). The citation by the Office of prior art, followed by the submission by Applicants of declaration evidence sufficient to obviate a rejection over that prior art, and followed by the citation of, and reliance upon, additional, previously unrecited, and even more remote prior art after the submission of the declaration evidence, frustrates the stated goal of the PTO in examining patent applications quoted above. MPEP § 706.02 (I) states:

I. CHOICE OF PRIOR ART; BEST AVAILABLE

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a **35 U.S.C. 102** or 103 rejection depends on a particular interpretation of a claim;

(B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or

(C) the most pertinent reference seems likely to be antedated by a **37 CFR 1.131** affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

MPEP § 706.02 (emphasis added). Applicants note that the citation of a "back up" rejection is only sanctioned where the closest prior art seems likely to be antedated by a declaration under 37 C.F.R. § 1.131. Such a procedure is not authorized where, as here, the closest prior art has been eliminated by a showing that the claimed invention is not obvious under 37 C.F.R. § 1.132.

MPEP § 707.07(g) states:

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See **MPEP § 904.03.**) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

MPEP § 707.07(g) (emphasis added). Applicants respectfully submit that where the Office has made a rejection over Ozaki, that rejection has been overcome, and now the Office makes a new ground of rejection over prior art that is further removed from the claims than was Ozaki, the Office has engaged in unnecessary piecemeal prosecution prohibited by MPEP § 707.07.

Finally, the Office is directed to MPEP § 716.02(e), which states, in pertinent part:

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the *claimed* invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." *In re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference

disclosure, deviations therefrom should be explained, *In re Finley*, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. *In re Armstrong*, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

I. < THE CLAIMED INVENTION MAY BE COMPARED WITH PRIOR ART THAT IS CLOSER THAN THAT APPLIED BY THE EXAMINER

Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over nonchlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the *prima facie* case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.).

MPEP § 716.02(e) (emphasis added).

Applicants respectfully submit that the Ozaki reference was closer prior art to Applicants' claims than Rutz and Storchheim, now relied upon by the Office for at least the reason that Ozaki was the basis of an obviousness rejection of claims 20-30, 34-38, 40, 48, and 49 without (in the view of the Office) the need for the citation of secondary references. See paragraph 5 of the Office action dated July 16, 2008. As a result, Applicants submit that they have already shown that the claimed invention is not obvious over the closest cited prior art, and should not be put to the time and expense of providing successive showings over progressively more distant prior art as the Office reshuffles its deck of references and deals Applicants a new set of rejections in each Office action. Applicants submit that the above rejection should be withdrawn for this reason alone.

In addition, even if Rutz combined with Storchheim was the closest prior art that the Office was able to find, the Office has not established a *prima facie* case of

obviousness, because even if the references were combined in the manner suggested by the Office, the claimed invention would not be obtained. Rutz is directed to a steel powder. Storchheim is directed to aluminum and alloys of aluminum. The Office states:

Storchheim further teaches that the method is applicable to powders such as steel (see col. 9).

Office action dated March 3, 2009 at page 5. However, column 9 of Storchheim states:

The quenching in water or other liquid will obtain a supersaturated solution and then the article may be allowed to naturally age at room temperature. For example, aluminum alloy particles may be hot pressed quickly and then immediately ejected and quenched. The hot pressed aluminum article may then be allowed to naturally age for four days at room temperature to provide a T-4 heat treated aluminum article. The aluminum article may, if desired, be further heat treated to T-6 condition by placing the article in a temperature of about 250° F. for a period of about 18 hours. For most metals, the number and kinds of alloying agents used for precipitation hardening are well known. Although only aluminum has been mentioned specifically as being hardened by precipitation, it is to be understood that other alloyed metals, such as magnesium or steel, be precipitation hardened.

Storchheim at column 9, lines 21-37 (emphasis added).

That magnesium or steel may be precipitation hardened is hardly a suggestion that the process disclosed in Storchheim, which is otherwise entirely directed to processing aluminum, should be applied to the disclosure of a steel powder in Rutz. Nowhere does column 9 of Storchheim suggest that the process disclosed therein would be applicable to the any metals other than aluminum. A worker having ordinary skill in the art, and who is put in view of Rutz, would not have any reason to look to Storchheim, a process that appears to be directed to aluminum and aluminum alloys, for a teaching of how to process steel. The properties of steel, on the one hand, and aluminum and its alloys, on the other hand, are very different with respect to hardness and other properties. The best that such a worker could hope to glean from the disclosure of Storchheim is that both steel and aluminum and magnesium can be

precipitation hardened. This is well known for steel, and the disclosure of Storchheim in this regard seems to be simply drawing a parallel to the precipitation hardening that occurs with steel as an indication of the type of precipitation hardening that is meant to be carried out with aluminum or its alloys according to the teachings of Storchheim. However, such a disclosure would not serve to teach an ordinary skilled worker about the applicability of the process of Storchheim (or isolated elements thereof) to the process of Rutz.

Even if such a worker were somehow motivated to combine the teachings of Rutz with those of Storchheim, the result would not be Applicants' claimed invention. For example, the Office asserts that Rutz discloses that the powder used therein may be atomized (Office action dated March 3, 2009 at page 3). Storchheim indicates that the particles used therein should have generally uniform sizes and shapes. See Storchheim at column 6, lines 30-36. Moreover, Storchheim states that spherical particles are particularly advantageous at column 8, lines 7-13. If a worker of ordinary skill in this art were to combine the teachings of Storchheim with those of Rutz, the result would be gas-atomized particles having a spherical shape, based upon the teachings described above. Applicants' claims, by contrast, recite that the particles are water-atomized. Water-atomized powders will have an irregular shape, as is recognized by those having ordinary skill in the art. Thus, combination of Rutz with Storchheim will not result in the claimed invention.

As another example, Rutz discloses several ranges for typically used compaction pressures. Storchheim uses a compaction pressure of 20,000 to 100,000 psi, which equates to 138 to 689 MPa. See Storchheim at column 5, lines 8-25. Thus, combining the teachings of Storchheim with those of Rutz would lead one having ordinary skill in

the art to use the lower compaction pressure of Storchheim. This is below the minimum of 800 MPa recited in Applicants' claims.

The Rutz and Storchheim references are directed to completely different processes that are incompatible with each other. If the Office insists on combining the reference teachings where an ordinary skilled worker would not, then the Office should also accept that all of the pertinent disclosure of Storchheim should be considered and combined, and not merely the disclosure of Storchheim that results from selective picking and choosing the features that support the Office's preconceived view that Applicants' claims are obvious. When all of the pertinent disclosure of Storchheim is considered, including disclosure that teaches away from Applicants' claims, it is very clear that the Office has failed to establish a *prima facie* case of obviousness because the result is not Applicants' claimed invention as explained above. Accordingly, this rejection should be withdrawn for this reason.

Moreover, as explained above, any *prima facie* case of obviousness that might be said to exist is rebutted by the previous declaration submitted under 37 C.F.R. § 1.132, which establishes nonobviousness with respect to the Ozaki reference, to which Rutz and Storchheim are merely cumulative. For this reason as well, this rejection should be withdrawn.

REQUEST FOR WITHDRAWAL OF FINALITY

The Office action states that:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Office action dated March 3, 2009 at page 9. However, the only amendment that Applicants made was to amend claim 20 to recite that the compaction is performed in a single step. Nowhere does the Office action even allege that the newly cited

Storchheim reference discloses this feature of claim 20. Accordingly, Applicants submit that it is not Applicants' amendment that necessitated the new ground of rejection. That the previous rejections over Ozaki were overcome by the submission of the declaration under 37 C.F.R. § 1.132, or that the previous rejections over Rutz and Kondo were overcome by Applicants' arguments are not valid reasons for including a new ground of rejection in a final Office action. MPEP § 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP § 706.07(a) (emphasis added). In this case, the Office has made new grounds of rejection over Storchheim. These new grounds of rejection are demonstrably not necessitated by the previous amendment to the claims made by Applicants, since the Office action does not even allege that Storchheim discloses the features added to the claims by that amendment. Accordingly, the Office has not complied with MPEP § 706.07(a), finality is premature, and withdrawal of finality is respectfully requested. Applicants respectfully request that the Office either grant or deny this request in the next Office action, so that Applicants can timely take any necessary and appropriate action to have finality withdrawn without incurring unnecessary extension fees.

CONCLUSION

Applicants submit that this application is in condition for immediate allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions about this application, or believes that any issues remain to be resolved, the Examiner is respectfully requested to contact the undersigned to arrange for a personal


or telephonic interview to resolve these issues prior to the issuance of another Office action.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:



Bruce D. Gray
Registration No. 35799

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620